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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|-----------------------|--------------------------------|------------------------|
| 09/848,520 | 05/03/2001 | Eric Christopher Berg | 8070L\$&M | 7535 |
| 27752 7590 07/09/2007 THE PROCTER & GAMBLE COMPANY INTELLECTUAL PROPERTY DIVISION - WEST BLDG. WINTON HILL BUSINESS CENTER - BOX 412 6250 CENTER HILL AVENUE CINCINNATI, OH 45224 | | | EXAMINER FERRIS III, FRED O | |
| | | | ART UNIT 2128 | PAPER NUMBER |
| | | | MAIL DATE 07/09/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|-------------------------------|-----------------------------|--|
| Office Action Summary | Application No. 09/848,520 | Applicant(s) BERG ET AL. | |
| | Examiner Fred Ferris | Art Unit 2128 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-7,9-13,15,17-20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-7,9-13,15, 17-20, and 22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. *This Office Action is responsive to applicant's arguments filed 25 April 2007.*

Claims 1-2, 5-7, 9-13, 15, 17-20, and 22 are currently pending in this application and remain rejected by the examiner.

Response to Arguments

2. *Applicant's arguments filed 25 April 2007 have been fully considered.*

*Regarding applicant's response to 102(b) rejections: In a nutshell, applicants now argue that copending application 09/565008 as disclosed in the IDS dated 26 January 2007 does not imply public use or sale of the instant invention and have cited *Invitrogen Corp v Biocrest Manufacturing*. In response the examiner submits the following:*

3. *Applicants believe that the instant situation should not be considered as constituting a public use under 35 U.S.C. Section 102(b) by applying the reasoning set forth in the *Invitrogen* case. In the *Invitrogen* case, *Invitrogen* admitted that it used the claimed process in its own laboratories before the critical date to grow cells to be used in other projects within the company; the district court determined that use of the invention in *Invitrogen's* general business of widespread research generated commercial benefits; the district court examined the totality of the circumstances and found that this use was "public"; the CAFC overruled the district court on this point; the CAFC held the fact that *Invitrogen* secretly used the cells internally to develop future*

products that were never sold, without more, is insufficient to create a public use bar to patentability; from the Invitrogen case, one can see that some uses within the confines of a corporation are permitted without invoking the statutory bar; as held in the Invitrogen case, this includes some uses that generate commercial benefits.

4. *The Federal circuit court has ruled in the case involving Kinzenbaw vs Deere & Co. in 1984 (222 USPQ 929) that "secrecy alone does not necessarily negate public use; as a general proposition, a commercial use by the inventor is a bar even if it is kept secret". The Federal circuit court has ruled in the case involving D.L. Auld Co. vs Chroma Graphics Corp. in 1983 (213 USPQ 13) that "thus if the inventor's assignee produces a product by a patented method and offers it for sale before the critical date, the right to a method patent is lost, even though the method is not accessible to the public".*

5. *The case cited by the applicants, Invitrogen Vs Biocrest, states on Page 6, Paragraph containing [* 18], "an accused infringer put the invention into public use; the accused infringer's public use came about because he had independently come upon both the method and the apparatus of the patents and continuously employed the alleged infringing machine and process for the production of... powder ... used in ... batteries which have been sold in quantity; thus the case was marked by an outright commercial use of the invention by someone other than the applicant, long before the applicant's filing date; those facts allowed the court to invalidate the patent at issue, and*

to observe that "the ordinary use of a machine or the practice of a process in a factory in the usual course of producing articles for commercial purposes is a public use".

The Supreme Court decided in Electric Storage battery Co. Vs Shimadzu, in 1939 that "the ordinary use of a machine or the practice of a process in a factory in the usual course of producing articles for commercial purposes is public use".

6. *As cited in the 09/565,008 application, the attorney faxed the presentation material for the P&G's presentation to SRC in early 1999 that discloses competing cause analysis. Therefore, the uptime analysis methods that the applicants are claiming have been disclosed outside the company in early 1999 and were known to outsiders.*

7. *The process claimed by the applicants was used to produce an improved manufacturing system. The improved manufacturing system was used to produce products which were shipped and sold one year before the filing date of the application. Therefore, the process claimed by the invention, which was not directly used to produce the products sold to the public was secretly used to make improved manufacturing system which was used to make and sell products. The improved manufacturing system was in commercial use and therefore the process used to make that improved manufacturing system was also in commercial use. This is commercial exploitation. The criterion to be used in such situation is to determine if the applicant or his assignee gained commercial benefits. The answer is yes in this case and therefore the process was in commercial use one year before the filing date of the application. Applicants*

have not argued that there is any distinction between the improved manufacturing system disclosed in the IDS and claimed subject matter of the instant application. Therefore the Claims 1-2, 5-7, 9-13, 15, 17-20, and 22 are rejected under 35 U.S.C. 102(b).

8. *Applicants have further argued that they never admitted that the invention was in public use or on sale and maintained that the claimed invention was not made public". The Examiner respectfully disagrees for the following reasons. In the IDS filed on November 1, 2004 in application 09/565,008, and February 28, 2005 of the instant application, Applicants have stated that the claimed process was used to produce an improved manufacturing system; and the improved manufacturing system was used to produce products that were shipped and sold one year before the filing date of the application. Therefore, the process claimed by the invention, which was not directly used to produce the products sold to the public was secretly used to make improved manufacturing system that was used to make and sell products. The improved manufacturing system was in commercial use and therefore the process used to make that improved manufacturing system was also in commercial use. This is commercial exploitation. The criterion to be used in such situations is to determine if the applicant or his assignee gained commercial benefits. The answer appears to be yes in this case and therefore the process was in commercial use and public use one year before the filing date of the application. Accordingly, the examiner maintains the 102(b) rejection.*

9. *Applicants have not argued any specific differences between the improved manufacturing system disclosed in applicants IDS and the invention as claimed.*

Conclusion

10. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. *Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred Ferris whose telephone number is 571-272-3778 and whose normal working hours are 8:30am to 5:00pm Monday to Friday. Any inquiry of a general nature relating to the status of this application should be directed to the group receptionist whose telephone number is 571-272-3700. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamini Shah can be reached at 571-272-2279. The Official Fax Number is: (571) 273 8300*

Fred Ferris, Primary Examiner
Simulation and Emulation, Art Unit 2128
U.S. Patent and Trademark Office

Art Unit: 2128

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July 2, 2007



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